

REMARKS/ARGUMENTS

Prior to entry of this amendment, claims 1-44 were pending in the application. Claims 1-44 were rejected under 35 U.S.C. § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Claims 1-33 were rejected under § 112, ¶ 2, as being incomplete for omitting essential steps or elements, such omission amounting to a gap between the steps or structure. Claims 1-23 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claims 1, 2, 5, 6, 8-14, 21-25, 27, 32, 34-36 and 42-44 were rejected under 35 U.S.C. § 102(e) as being anticipated by US Patent No. 6,298,327 to Hunter et al. ("Hunter"). Claims 4, 15, 17-20, 30 and 38-41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hunter in view of US Patent No. 6,434,580 to Takano et al. ("Takano"). Claims 7, 16, 31, 33 and 37 were rejected under § 103(a) as being unpatentable over Hunter in view of US Publication No. 2001/0049707 to Tran ("Tran"). Claims 3, 26, 28 and 29 were rejected under § 103(a) as being unpatentable over Hunter in view of US Publication No. 2001/0037460 to Porcari ("Porcari").

This amendment cancels claims 1-10, 18 and 24-31 and amends claims 11-15, 17, 19-23, 32-36 and 38-44. This amendment also adds new claims 45-64. Hence, after entry of this Amendment, claims 11-17, 19-23 and 32-64 stand pending for examination.

Information Disclosure Statement

The applicant filed an information disclosure statement on December 11, 2001. The Examiner considered the information disclosure statement on February 25, 2004, but three of the references on the information disclosure statement were not initialed by the Examiner, indicating that the Examiner did not consider those references. A copy of the information disclosure statement is submitted herewith, with the unconsidered references highlighted. Additional copies of those references, with a new information disclosure statement, are also

submitted herewith. The applicant respectfully requests that the Examiner consider these references.

Claim Amendments

New independent claims 45, 63 and 64 have been added, and new dependent claims 46-62 have been added to depend from claim 45. Claim 45 recites a method of generating an information disclosure statement in a form suitable for filing with an official patent office. Claims 63 and 64 recite a system and a computer program, respectively, that correspond generally to the method of claim 45. Support for the added claims may be found in the application at, inter alia, lines 22-29 of page 4, lines 1-32 of page 7, lines 6-35 of page 5, lines 1-6 of page 6, lines 22-29 of page 9, lines 6-9 of page 14, lines 26-35 of page 15, lines 1-3 of page 16, lines 23-28 of page 12, and Fig. 4.

In addition, claims 1-15, 17, 19-23, 32-36 and 38-44 have been amended. Most of the amendments simply amend the claims to depend from the proper base claims. Other amendments are included to more clearly define the scope of the invention. For example, in claims 13 and 14, the term "coupled to" has been replaced with "in communication with," which more accurately describes the relationship between the recited elements. Similarly, in claim 19, the term "receiving a second signal indicating" has been replaced with "the computer determining," and claim 40 has been similarly amended. In claim 20, the term "automatically" has been replaced with "the computer." The term "IDS information" has been removed from claims 20 and 41. Claim 39 has been amended to provide proper antecedent basis for that claim. It is submitted that these amendments do not narrow the scope of the claims.

Throughout the claims, references to a "patent office" have been replaced by references to an "official patent office" to provide proper antecedent basis. Support for this term may be found in the application at, inter alia, at lines 30-35 of page 4 and lines 1-5 of page 5.

§ 112 Rejections

Claims 1-44 were rejected under 35 U.S.C. § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. It is believed that the new claims and the amendments to the existing claims address each of the grounds for these rejections, and the applicant respectfully requests the withdrawal of these rejections.

Claims 1-33 were rejected under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential steps or elements. Many of the grounds for these rejections have been addressed by the amendments to the claims. Moreover, the applicant respectfully submits, as in a prior response, that the “omitting essential elements” rejections are improper in this context. For example, the office action questions how the instructions perform various operations. The claims, however, do not recite that the “instructions” themselves do anything. Merely by way of example, claim 33 recites that the “computer-readable memory further includes computer instructions to provide access to the electronic information disclosure statement to multiple users over a network.” One skilled in the art would have no trouble understanding that the “instructions to provide access” are to be executed by a computer to provide access to the multiple users. One skilled in the art also would appreciate that there are many procedures to control access to an application or a document with a computer, and that this claim would read on any of these procedures. Hence, the applicant respectfully submits that the claims reciting “instructions to” are sufficiently clear to comply with § 112, ¶ 2, and the applicant respectfully requests the withdrawal of those rejections.

With respect to office action’s question about “what information is extracted and from what reference information,” the claim to which that question applies has been canceled. New claim 50, however, recites “the computer extracting a relevant portion of a set of reference information from the at least one electronic document.” The term “reference information,” to the extent it is not clear on its face, is described in the application at lines 13-14 of page 5. As recited in claim 50, a relevant portion of a set of reference information is extracted from an

electronic document. The applicant submits that claim 50 complies fully with the requirements of § 112, ¶ 2.

§ 101 Rejections

Claims 1-23 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. New claim 45 recites, inter alia, “a computer providing an interface for a user to search a plurality of electronic documents for at least one electronic document that is relevant to a patent application;” “the computer allowing a user to identify the at least one relevant electronic document for disclosure to a patent office;” and “the computer incorporating at least a portion of the electronic document into an electronic information disclosure statement, wherein the electronic information disclosure statement comprises a form suitable for filing with an official patent office.” The applicant submits that new claim 45, and claims 2-17 and 19-23, which depend therefrom, recite sufficient technological basis to comply with § 101, and the applicant respectfully requests the withdrawal of the § 101 rejections.

§§ 102 and 103 Rejections

Claims 1, 2, 5, 6, 8-14, 21-25, 27, 32, 34-36 and 42-44 were rejected under § 102(e) as being anticipated by Hunter, claims 4, 15, 17-20, 30 and 38-41 were rejected under § 103(a) as being unpatentable over Hunter in view of Takano, claims 7, 16, 31, 33 and 37 were rejected under § 103(a) as being unpatentable over Hunter in view of Tran, and claims 3, 26, 28 and 29 were rejected under § 103(a) as being unpatentable over Hunter in view of Porcari.

The applicant submits that the claims, as amended, are allowable over any combination of the cited references. Merely by way of example, new claim 45 recites “the computer incorporating at least some information from the at least one electronic document into an electronic information disclosure statement, wherein the electronic information disclosure statement comprises a form suitable for filing with an official patent office.” None of the cited references teach or suggest this element of claim 45.

The office action asserts that Takano teaches the electronic submission of patent applications and argues that “filing patents electronically is an ordinary practice in the industry and an IDS is often filed along with a patent application.” While this statement may be true, neither Hunter nor Takano teaches that information from an electronic document may be incorporated into an electronic information disclosure statement, wherein the electronic information disclosure statement comprises a form suitable for filing with an official patent office. Instead, both Hunter and Takano contemplate, at most, inserting information about a prior art reference into a patent application. This does not teach or suggest the recited element of claim 45, and neither reference provides any suggestion or motivation that the references might be modified to function in the recited manner.

Nor do any of the cited references teach or suggest “a computer providing an interface for a user to review at least one electronic document that is relevant to a patent application,” as recited by claim 45. While Hunter does disclose the concept of including prior art references in an invention disclosure, nothing in Hunter appears to teach or suggest providing an interface for a user to review at least one electronic document. Nor do the other references teach or suggest this element of claim 45.

Consequently, claim 45 is allowable over the cited references, taken either alone or in combination. For at least similar reasons, independent claims 63 and 64 are allowable. Dependent claims 11-17, 19-23, 32-44 and 46-62 are allowable as depending from allowable base claims and as being directed to specific novel substitutes.

Merely by way of example, claim 46 recites “printing the electronic information disclosure statement to create an information disclosure statement for mailing to the official patent office.” None of the cited references teach or suggest this element. Likewise, none of the cited references teach or suggest either “allowing the user to browse the Internet to find at least one relevant electronic document,” as recited by claim 48, or “parsing the at least electronic document for a relevant portion of a set of reference information,” as recited by claim 53.

Hence, the applicant submits that all claims now pending in the application are allowable over the cited references, and the applicant therefore respectfully requests the allowance of all pending claims.


Conclusion

In view of the foregoing, the applicant believes all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

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